

REMARKS

Applicant graciously acknowledges the telephone interview conducted on December 7, 2005. With this paper, Applicant has attempted to address the issues discussed in the interview. Applicant has studied the Office Action dated June 15, 2005 and the Advisory Action dated September 22, 2005 and has made amendments to the claims. Claims 1, 2 and 4-18 are pending. Claims 1, 8, 11 and 17 are independent claims. Claims 1, 2, 4-8 and 11-18 have been amended. No new matter has been entered. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 102 Rejections

Claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Roeck et al. (“Roeck” U.S. Patent No. 6,574,796). This rejection is respectfully traversed.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

Claim 1 has been amended to more clearly disclose the invention and to recite a message processor that stores the detected configuration file only when the detected configuration file is a more recent version than the configuration file previously stored. It is respectfully submitted that Roeck fails to disclose this limitation and the Examiner apparently agrees, as evidenced by the statement, at page 8 of the Office action that Roeck “fails to teach of a process, which stores the information in memory only when the detected information is more recent than the one already stored.”

Claim 1 has been amended to incorporate the subject matter of claim 3, which has been canceled without prejudice with this paper. Since claim 3 was rejected under 35 U.S.C. 103(a) further in view of DiNatale et al. (“DiNatale” WIPO Pub. No. WO 02/48897 A1), the subsequent discussion with regard to DiNatale with regard to that rejection is applicable. It is respectfully asserted that the subject matter incorporated into claim 1 from claim 3 is allowable over DiNatale and, therefore, claim 1 is also allowable over DiNatale.

Claims 8, 10, 11 and 13-16 were rejected under 35 U.S.C. § 102(e) as being anticipated by DiNatale et al. (“DiNatale” WIPO Pub. No. WO 02/48897 A1). This rejection is respectfully traversed.

With regard to independent claim 8, it is respectfully noted that claim 8 has been amended to recite a delimiter part having a finite size such that the file name part and the file version part border the delimiter part therebetween. Support for the amendment is found in the specification of the present invention at page 10, ll. 8-12, page 12, ll. 13-16 and FIG. 6B. It is respectfully submitted that DiNatale fails to teach this limitation.

The Examiner asserts, at page 4 of the Office action, that DiNatale “shows a file format which has specified lengths for the data which separates the data providing a delimiter in between” in Figure 4 and, at page 17 of the Office action, the Examiner further asserts that Figure 4 of DiNatale shows a “visual representation of a delimiter and it is inherent to have a delimiter when separating data in a file.” Applicant respectfully disagrees with the Examiner’s interpretation of DiNatale.

It is respectfully noted that, “[d]rawings and pictures can anticipate claims if they clearly show the structure which is claimed ... the picture must show all the claimed structural features and how they are put together ... [w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurements of the drawing features are of little value.” See MPEP section 2125. It is further respectfully noted that neither FIG. 4 nor the portion of DiNatale related to FIG. 4 discloses any “delimiter part.” Moreover, it is respectfully submitted that the bold lines that are “visually” shown between the various elements represented by numerals 110-122 in Figure 4 of DiNatale, which the Examiner apparently interprets as the “delimiter,” do not have a reference numeral assigned. It is respectfully submitted that, in view of the lack of disclosure of any “delimiter part” in DiNatale, the Examiner’s asserted disclosure of “a file format which has specified lengths” is not sufficient to teach a delimiter part having a finite size such that the file name part and the file version part border the delimiter part therebetween recited in the claim.

With regard to the Examiner’s assertion that it is “inherent” to have a delimiter when separating data in a file, Applicant agrees that inherency is a legally viable method for interpreting a reference. Verdegaal Bros., Inc. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). However, it is respectfully noted that the “examiner

must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

To serve as an anticipation when the reference is silent about the asserted herein characteristic, such a gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill.

Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (emphasis supplied). It is well settled that,

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Continental Can, 20 USPQ2d at 1749 (emphasis original), quoting In re Oerich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)).

It is respectfully noted that the Examiner has not provided any basis for the asserted “inherency” and it is respectfully submitted that the asserted “visual representation of a delimiter” in Figure 4 of DiNatale is conjecture on the part of the Examiner that is not supported by the disclosure. As was further respectfully submitted in the telephone interview on December 7, 2005, it is just as plausible to interpret the bold lines that are “visually” shown between the various elements represented by numerals 110-122 in Figure 4 of DiNatale as an attempt by the Applicant in DiNatale to show the various fields of the “operating software file name.” Moreover, given the lack of disclosure in DiNatale regarding how the various fields in the “operating software file name” are extracted, it is just as plausible that no “delimiter” is “inherent” in the disclosure of DiNatale since the file format has “specified lengths for the data” which would allow the various fields to be extracted according to their “specified length.”

The Examiner asserted in continuation sheet of the Advisory action that a “delimiter is not part of the data string.” Applicant respectfully disagrees with the Examiner’s statement.

As was respectfully noted in the telephone interview on December 7, 2005, the finite size of the delimiter recited in claim 8 means that the delimiter IS part of the data string of the present invention. As was further respectfully noted in the interview, the motivation for the finite size of the delimiter is to enable use of the conventional DHCP message format. See specification at

page 11, ll. 4-6 and page 14, ll. 20-22. Therefore, as was respectfully submitted in the interview, DiNatale fails to teach a delimiter part having a finite size such that the file name part and the file version part border the delimiter part therebetween, as recited by claim 8.

With regard to independent claim 11, it is respectfully noted that claim 11 has been amended to recite downloading the detected configuration file only if the name of the detected configuration file is different from the name of the previously stored file or if the detected configuration file is of a more recent version than the previously stored configuration file. It is respectfully submitted that DiNatale fails to teach this limitation. Since claim 11 has been amended to incorporate subject matter similar to that of canceled claim 3, the subsequent discussion with regard to the rejection of claim 3 under 35 U.S.C. § 103(a) in view of DiNatale is applicable.

It is respectfully asserted that DiNatale fails to disclose each element of independent claims 8 and 11 and, therefore, the claims are allowable over the cited reference. It is further respectfully asserted that claim 10, which depends from claim 8, and claims 13-16, which depend from claim 11, also are allowable over the cited reference.

§ 103 Rejections

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck et al. in view of Welles, II et al. (“Welles” U.S. Pat. No. 6,532,495). This rejection is respectfully traversed.

It is respectfully submitted that Welles fails to cure the deficiencies of Roeck with respect to independent claim 1 that were submitted previously with regard to the 102(e) rejection. Therefore, it is respectfully asserted that claim 1 is allowable over the cited references, as is claim 2 based on its dependence from claim 1.

Claims 3, 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of DiNatale. This rejection is respectfully traversed.

It is respectfully noted that claim 3 has been cancelled without prejudice with this paper. It is, therefore, respectfully submitted that the rejection is moot with respect to claim 3 and it is respectfully requested that the rejection be withdrawn. The following discussion of claim 3 is with respect to the limitations of claim 3 which have been incorporated into claim 1.

As previously respectfully noted with regard to the 35U.S.C. § 102 rejection of independent claim 1, the Examiner states, at page 8 of the Office action, that Roeck “fails to teach of a process, which stores the information in memory only when the detected information is more recent than the one already stored.” The Examiner further asserts at page 8 that DiNatale, at page 7, ll. 29-32, teaches “a process where the information is saved in memory if it is more recent than the previous information.” Applicant respectfully disagrees with the Examiner’s interpretation of DiNatale.

As was respectfully submitted in the telephone interview on December 7, 2005, DiNatale discloses the very prior art process that the present invention seeks to improve upon. As was respectfully noted in the telephone interview on December 7, 2005, DiNatale teaches that “in place of the operating software file name as taught by the prior art, the configuration file includes the name of a cable modem operating software table.” Page 7, ll. 8-10. As was respectfully noted in the interview, DiNatale is directed to accommodating “a wide variety of cable modems used on a cable system, including modems from various manufacturers and also different modem numbers from a single manufacturers.” Page 7, ll. 14-28. As was respectfully submitted in the interview, DiNatale compares the version of a presently downloaded operating software table to that of a previously downloaded operating software table after the configuration file is downloaded, thereby still incurring the additional processing time of the prior art process. See DiNatale at page 7, line 29 to page 8, line 2.

As was respectfully submitted in the telephone interview on December 7, 2005, FIG. 3 of DiNatale discloses “the [TFCP] configuration file downloaded at the step 80.” See DiNatale at page 7, ll. 4-7. As was further respectfully submitted in the interview, Background Art FIG. 2 of the present specification discloses that the cable modem “downloads a configuration file having defined parameter values in which a data transmission/ reception method with respect to the cable modem termination system 20 is defined (step S8).” See specification at page 4, ll. 15-19. Moreover, as was respectfully submitted in the interview, the similarity between FIG. 3 of DiNatale and Background Art FIG. 2 of the present specification shows that DiNatale is directed to the very “ineffective” method of “download[ing] the configuration file every time when the cable modem is initialized” that the present invention is directed to improving. See specification at page 5, ll. 8-11.

On the other hand, as was respectfully noted in the telephone interview on December 7, 2005, FIG. 5, to which claim 3 is directed, discloses that the first configuration file is downloaded from the TFTP server (in step S16) **only** if the first configuration file name and second configuration file name are found to be different (in step S15) or the first configuration file version is found to be later than the second configuration file version (in step S20). As was respectfully submitted in the interview, the portions of DiNatale that the Examiner asserts as teaching “a process where the information is saved in memory if it is more recent than the previous information” do not disclose a process related to storing the “configuration file” in memory at “step 80,” but rather a process directed to storing “the operating software table file” in memory at “step 88” and that “step 88” is performed **after** the configuration file has already been downloaded in “step 80.” See DiNatale at page 7, line 29 to page 8, line 2.

It is respectfully submitted that it would **not** have been obvious to a person of ordinary skill in the art to modify the Roeck invention by the teachings of DiNatale, with regard to the “operating software table file,” in order to store the detected configuration file in memory only when the detected configuration file is more recent than the previously stored configuration file given that DiNatale teaches to store the detected configuration file **regardless** of the version.

Therefore, it is respectfully submitted that the limitations of cancelled claim 3 are not obvious in view of the cited references. It is further respectfully submitted that independent claim 1, which has been amended to incorporate the limitations of claim 3, is allowable over the cited references, as are claims 4 and 7, which depend from claim 1.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of Gatherer et al. (“Gatherer” U.S. Pat. No. 6,549,584). This rejection is respectfully traversed.

It is respectfully submitted that Gatherer fails to cure the deficiencies of Roeck with respect to independent claim 1 that were submitted previously with regard to the 102(e) rejection of claim 1 and the 103(a) rejection of claim 3. Therefore, it is respectfully asserted that claim 1 is allowable over the cited references, as is claim 5 based on its dependence from claim 1.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of Gatherer as applied to claim 5 and further view of DiNatale. This rejection is respectfully traversed.

As was previously respectfully submitted, claim 1 is allowable over the cited references, as is claim 6 based on its dependence from claim 1.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Beser (U.S. Pat. No. 6,775,276). This rejection is respectfully traversed.

It is respectfully submitted that Beser fails to cure all the deficiencies of DiNatale with respect to independent claim 8 that were submitted previously with regard to the 102(e) rejection. Therefore, it is respectfully asserted that claim 8 is allowable over the cited references, as is claim 9 based on its dependence from claim 8.

Claims 12, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Gatherer. This rejection is respectfully traversed.

With respect to claim 12, it is respectfully submitted that Gatherer fails to cure all the deficiencies of DiNatale with respect to independent claim 11 that were submitted previously with regard to the 102(e) rejection. It is respectfully asserted that claim 11 is allowable over the cited references, as is claim 12 based on its dependence from claim 11.

With respect to independent claim 17, it is respectfully noted that claim 17 has been amended to recite limitations similar to claims 1 and 8. As was previously submitted, DiNatale does not teach a process directed to comparing the file names and file versions of a detected configuration file and a stored configuration file, as recited in claim 1, nor the delimiter part recited in claim 8. As was previously submitted with regard to the rejection of claim 5, Gatherer fails to cure the deficiency with regard to claim 1. It is further respectfully submitted that Gatherer fails to teach a delimiter part.

Therefore, it is respectfully asserted that independent claim 17 is allowable over the cited references. It is further respectfully asserted that claim 18, which depends from claim 17, also is allowable over cited references.

CONCLUSION

In light of the above remarks, Applicant submits that claims 1, 2 and 4-18 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

LEE, HONG, DEGERMAN, KANG &
SCHMADEKA

Date: December 15, 2005

By: 

Richard C. Salfelder
Registration No. 51,127
Attorney for Applicant

Customer No. 035884

801 S. Figueroa Street, 14th Floor
Los Angeles, California 90017
Telephone: 213-623-2221
Facsimile: 213-623-2211